IFW 1713

TC 6072

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: **Luigi Resconi et al.**

Serial Number: **10/536,857**

Filed: **May 27, 2005**

For: **PROCESS FOR PREPARING 1-BUTENE COPOLYMER AND COPOLYMER THEREOF**

Group Art Unit: **1713**

Examiner: **Caixia Lu**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 23, 2006

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the restriction requirement under 35 U.S.C. 121 and 372, dated March 1, 2006, for which a one-month period for response was set.

Claims 1-17 are pending in this application. The Office Action has set forth a requirement for restriction of the prosecution of this application to the following Groups of claims:

I. Claims 1-10, drawn to a polymerization process for making isotactic 1-butene copolymer; or

II. Claims 11-17, drawn to an isotactic 1-butene copolymer.

Applicants hereby provisionally elect Group I, claims 1-10 with traverse.

The Examiner contends that the inventions listed in Groups I-II do not relate to a single general inventive concept under PCT 13.1, because under PCT Rule 13.2 they lack the same or corresponding special technical features. The Examiner contends that the

recited copolymers do not make a contribution over the prior art, i.e., the special technical feature(s) is anticipated by or obvious in view of the prior art (specifically, U.S. Patent No. 5,859,159 of Rossi et al. ("Rossi")); so that unity of invention is lacking and restriction is appropriate. However, the Examiner has not provided any specific citation within Rossi or any other reference upon which to support the conclusion as to either anticipation or obviousness.

The subject matter of Group I (claims 1-10) are drawn to a *especially adapted process* for preparing the isotactic 1-butene copolymers of Group II (claims 11-17). 37 C.F.R. 1.475(b)(2) clearly states that "[a]n international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (1) A product and a process especially adapted for the manufacture of said product". Therefore, Unity of Invention does exist between all the recited claims.

The Examiner has also required the election of a single species of metallocene complexes represented by formula (I) and formulas (II)-(III). The Examiner contends that these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicants provisionally elect the metallocene compound represented by formula (I) together with formula (III), which defines T^1 and T^2. Claims readable on the elected species include claims 1-10. Applicants traverse the species election requirement since Applicants have satisfied the single inventive concept as required by PCT Rule 13.1 as discussed above.

For the above reasons, the Examiner is respectfully requested to reconsider and withdraw the restriction and election of species requirement.

This is intended to be a complete response to the Office Action dated March 1, 2006. The Applicants invite the Examiner to direct any questions or comments to the undersigned at the telephone number given below. An early and favorable action on the merits is solicited.

No payment is believed to be due; however, the Commissioner is hereby authorized to charge U.S. PTO deposit account 08-2336 any payment due and to credit any overpayment thereto.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with sufficient postage thereon with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 23, 2006.

March 23 2006
Date of Signature